

by Naim *et al.*, and a rejection of Claims 1-4, 7-11, 13, 17-20, and 22 under 102(e) as anticipated by Camden '862.

#### **Response**

Claims 17-19 and 22 were canceled in the response mailed January 29, 2002. For a prior art reference to anticipate a claimed invention, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566-1568 (Fed. Cir. 1990).

Regarding paragraphs 4 and 5 of the Office Action of November 6, 2001 stating a rejection of Claim 1: Where R is heterocycloalkyl or unsubstituted phenyl has been removed from Claim 1. Therefore, Claim 1 is not anticipated by Agarwal *et al.* or Ram *et al.*

Regarding paragraphs 4 and 6 of the Office Action of November 6, 2001 stating a rejection of Claims 7, 19, and 20: Where R is alkyl has been removed from Claim 7. Claim 19 is canceled. Claim 20 is dependent upon Claim 7. Therefore, Claims 7 and 20 are not anticipated by Naim *et al.*

Regarding paragraphs 6 and 7 of the Office Action of November 6, 2001 stating a rejection of Claims 1-4, 7-11, 13, 17-20, and 22: Where R is haloalkyl, cycloalkyl, alkoxy, or alkenyl has been removed from independent Claims 1, 7, and 25. Claims 17-19 were canceled. Claims 2, 3, and 4 are directly or indirectly dependent upon Claim 1 and Claims 8-11, 13, and 20 are directly or indirectly dependent upon Claim 7. Since Claims 1 and 7 are not anticipated by Camden '862, dependent claims thereon are also not anticipated by Camden '862.

The invention as now claimed is not disclosed in Agarwal *et al.*, Ram *et al.*, Naim *et al.*, or Camden '862 and therefore is not anticipated under §102(b) or §102(e). Applicants request that this rejection be withdrawn.

### **III. Communication Regarding the Rejection of Claims under §103(a) of the Office Action mailed November 6, 2001**

The Communication cited the Office Action as stating that Claims 2-16 and 19-25 were rejected as unpatentable over Agarwal *et al.* or Ram *et al.*, Claims 8-16 and 21-25 were rejected as unpatentable over Naim *et al.*, and Claims 5, 12, 14, 15, 21, 23, 24, and 25 were rejected as unpatentable over Camden '862.

#### **Response**

Regarding paragraphs 8 and 9 of the Office Action of November 6, 2001 stating the obligation under 37 CFR 1.56: The response mailed January 29, 2002 stated that the subject matter of the claims was commonly owned at the time the claimed invention was made.

Claims 5, 6, 12, 16-19, and 21-24 are canceled. A difference in the prior art and the claims at issue is the substituents on the benzimidazole portion of the claimed compound. The Federal Circuit has required

that specific support must be found in the prior art that “suggests” or “teaches” the modification necessary to resolve the differences of the prior art with a claimed invention. *In re Grabiak*, 226 USPQ 870 (Fed. Cir. 1985). Applicants submit that no such support for making the structural and chemical changes to the compounds of Agarwal *et al.*, Ram *et al.*, Naim *et al.*, or Camden necessary to resolve the differences with the claimed invention is present in any of the cited references, or combinations thereof.

Regarding paragraphs 8 and 10 of the Office Action of November 6, 2001 stating a rejection of Claims 2-16, and 19-25: Claims 5, 6, 12, 16, 19, and 21-24 are canceled. Where R is heterocycloalkyl or unsubstituted phenyl has been removed from independent Claims 7 and 25. Neither Agarwal *et al.* nor Ram *et al.* provide specific support that “suggests” or “teaches” the modification necessary to resolve the differences of the prior art with the invention as claimed in independent Claims 7 and 25. Claims 2, 3, and 4 are directly or indirectly dependent upon Claim 1 which claim is not included in the present rejection. Therefore, Claims 2, 3, and 4 are patentable over Agarwal *et al.* or Ram *et al.* Claims 8-11, 13-15, and 20 are directly or indirectly dependent upon Claim 7. Since Claim 7 is patentable over Agarwal *et al.* or Ram *et al.*, dependent claims thereon are also patentable.

Regarding paragraphs 8 and 12 of the Office Action of November 6, 2001 stating a rejection of Claims 8-16, and 21-25: Claims 12, 16, and 21-24 are canceled. Where R is alkyl has been removed from independent Claims 7 and 25. Naim *et al.* lacks specific support that “suggests” or “teaches” the modification necessary to resolve the differences of the prior art with the invention as claimed in independent Claim 7 or 25. Claims 8-11, 13-15, and 20 are directly or indirectly dependent upon Claim 7. Since Claim 7 is patentable over Naim *et al.*, dependent claims thereon are also patentable.

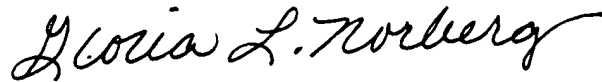
Regarding paragraphs 8 and 13 of the Office Action of November 6, 2001 stating a rejection of Claims 5, 12, 14-15, 21, 23, 24, and 25: Claims 5, 12, and 21-24 are canceled. Where R is haloalkyl, cycloalkyl, alkoxy, or alkenyl has been removed from the independent Claims 7 and 25. Camden lacks specific support that “suggests” or “teaches” the modification necessary to resolve the differences of the prior art with the invention as claimed in independent Claim 7 or 25. Claims 14 and 15 are directly or indirectly dependent upon Claim 7. Since Claim 7 is patentable over Camden, dependent claims thereon are also patentable.

Applicants therefore respectfully request that this rejection be withdrawn.

#### IV. Conclusion

It is believed that all matters of the Communication have been addressed. Reconsideration and an early indication of the allowability of the claims are earnestly requested. Should the Examiner have any questions, comments or suggestions that would expedite the prosecution of the present case to allowance, Applicants' undersigned representative earnestly requests a telephone conference at (512) 499-6200.

Respectfully submitted,



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